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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,894	09/23/2003	Robert M. Soule III	283-392.12	2236

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WALL MARJAMA & BILINSKI
101 SOUTH SALINA STREET
SUITE 400
SYRACUSE, NY 13202

EXAMINER

LE, UYEN CHAU N

ART UNIT PAPER NUMBER

2876

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

(14)

Office Action Summary

Application No.

10/669,894

Applicant(s)

SOULE ET AL.

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-18, 47-54 and 69-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-18, 47-54 and 69-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05/02/06, 05/17/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prelim. Amdt/Amendment

1. Receipt is acknowledged of the Amendment filed 02 May 2006.

Claim Objections

2. Claim 13 is objected to because of the following informalities:

Re claim 13, line 5: Substitute "a formatted file" with -- said formatted file --.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 13 and 86-88 are rejected under 35 U.S.C. 102(b) as being anticipated by Sheppard (US 6026397 A).

Re claims 13 and 86-88: Sheppard discloses a symbol generator including: a graphical user interface including a

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first data input area facilitating entry of a designator for a formatted file (fig. 19), and a second data input area facilitating entry of command data (i.e., parameters data); an encoder encoding into at least one symbol a formatted file in accordance with said designator and a command in accordance with said input command data (fig. 20; col. 23, lines 8-43).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in

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order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 14 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheppard in view of Liu (US 5764774 A). The teachings of Sheppard have been discussed above.

Re claims 14 and 17-18: Sheppard has been discussed above, but is silent with respect to storing a formatted file onto a portable device, whether encoded symbol data is to be compressed or encrypted prior to being encoded into a symbol, respectively.

Liu teaches an encoding system where the source data can be received from a data storage device, the coding control 12 determines whether the source data is to be encrypted or compressed, and the determination is based on the data received from the user (col. 5, lines 40-65).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Liu into the system as taught by Sheppard in order to provide Sheppard with a more secure system wherein the data is encrypted prior to encoded. Furthermore, such modification would provide Sheppard with a greater capacity to encode data due to the compressed data (i.e., more data can be encoded within one barcode).

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8. Claims 15-16, 47-54 and 69-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheppard in view of Hashimoto et al (US 6902114 B2). The teachings of Sheppard have been discussed above.

Re claims 15-16, 47-54 and 69-72: Sheppard has been discussed above, but is silent with respect to encode the formatted file into at least one symbol; automatically changes a number of symbols to encode depending; indicate a number of symbols to be encoded; encoding a set of barcodes, a field indicating a total number of symbols of the set, respectively.

Hashimoto et al teaches an encode method and system where the user specifies all setup value; the capacity of the inputted data is greater than the predetermined number, the data is encoded into more than one barcode; wherein each of the encoded barcode includes a total number of barcodes making up the setting group and a serial number indicating the order of the barcode in the barcodes making up the setting group (figs. 4-7; col. 8, line 1 through col. 10, line 41).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Hashimoto et al into the system as taught by Sheppard for intended use (i.e., encoding data into barcode symbols). Furthermore, such modification would decrease

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occurrence of read errors due to the division of data into a plurality of barcodes (i.e., at the scanning time, a distance is kept between the bar code reader and a bar code label, whereby a beam is scattered and thus the scan width widens, but the spot worsens, degrading the read accuracy. Therefore, to ensure precise read, the original data needs to be placed in a proper bar code length), thus providing a more accurate system.

Sheppard as modified by Hashimoto et al has been discussed above and further discloses the graphical interface may include additional input boxes to allow for input of information with respect to other parameters (col. 8, lines 16-18), but is silent with respect to the user indicating number of symbols to be encoded, number of bytes of data into a to-be encoded barcode, and whether a viewable field designated for encoding will be displayed at the time when a symbol encoding the viewable file is read, respectively.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the additional input boxes of Sheppard/Hashimoto et al to provide the user with the flexibility in selecting desired specific parameters, thus providing a desired encoding result.

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9. Claims 73-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheppard in view of Barile et al (US 5837986 A). The teachings of Sheppard have been discussed above.

Re claims 73-85: Sheppard has been discussed above, but is silent with respect to encoding into the symbol a command which when run by a reader that reads the symbol causes the reader to execute one of a plurality of file opening programs.

Barile et al teaches the reader 3 is programmed/reprogrammed by reading barcode 14 (figs. 1 & 2; col. 8, lines 30+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Barile et al into the system as taught by Sheppard in order to provide Sheppard with a more versatile system which can be used to reprogram the reader instantaneously and accurately upon scanning the barcode. Furthermore, such modification would have been an obvious engineering variation, well within the ordinary skill in the art, for intended use due to the fact that a barcode can be encoded with any type of information/data, and therefore an obvious expedient.

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Response to Arguments

10. Applicant's arguments with respect to claims 1-80 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patent to Tehranchi et al (US 6873435 B1) is cited as of interest and illustrates a similar structure to a user interface for an encoding symbol generator.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Uyen-Chau N. Le
Primary Examiner
Art Unit 2876

July 5, 2006